

REMARKS

Claims 1-9 are all the claims pending in the application. Claim 7 has been amended to depend from claim 6. Therefore, no new matter has been amended.

Claims 1-3, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,289,640 to Ueda *et al.* ("Ueda '640").

Additionally, claims 4 and 7-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ueda '640.

Applicants respectfully traverse these rejections.

Claim 1 presently recites a pressure-sensitive adhesive layer.

Referring to page 2 of the Office Action, the Examiner is asserting that the laminated rubber layer 33 as disclosed in Ueda '640 is identical to the claimed pressure-sensitive adhesive layer.

Applicants respectfully submit that it has not been established that the laminated rubber layer 33 as disclosed in Ueda '640 is necessarily identical to the claimed pressure-sensitive adhesive layer. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing disclosed in the reference. *See* MPEP § 2112 (IV). The fact that a certain characteristic may be present is insufficient. *Id.*

The laminated rubber layer 33 is not necessarily identical to the claimed pressure-sensitive adhesive layer. Ueda '640 does not specify the type of rubber present in the laminated rubber layer 33. Such a generic disclosure of rubber would not necessarily provide that the laminated rubber layer is a pressure-sensitive adhesive layer. If anything, the rubber present in

the laminated rubber layer 33 is provided for the purpose of absorbing an external force, as the seismic isolation sliding support disclosed in Ueda '640 is used to support a building. From a technical point of view, an impact absorbing rubber, as those present in the laminated rubber layer 33, would not necessarily work as the claimed pressure-sensitive adhesive layer.

Given that the laminated rubber layer 33 is not necessarily identical to the claimed pressure-sensitive adhesive layer, a person of ordinary skill in the art would not have been motivated to modify the laminated rubber layer 33 into the claimed pressure-sensitive adhesive layer.

For the above reasons, it is submitted that Ueda does not disclose, teach or suggest the pressure-sensitive adhesive layer of claim 1.

Further, claims 2-9 depend directly or indirectly from claim 1. Thus, claims 2-9 are neither anticipated by or rendered obvious from Ueda '640 for at least the same reasons as claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 10/802,868

Docket No: Q80457

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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Date: February 23, 2007


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